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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,635	07/27/2001	Paul G. Allen	4000.2.44	1204

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DIGEO, INC C/O STOEL RIVES LLP
201 SOUTH MAIN STREET, SUITE 1100
ONE UTAH CENTER
SALT LAKE CITY, UT 84111

EXAMINER
DESIR, JEAN WICEL

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,635

Applicant(s)

ALLEN ET AL.

Examiner

Jean W. Désir

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shintani et al (US 6,532,592) in view of Elliott et al (6,442,328).

Claim 1:

Shintani discloses:

"A wireless receiver for receiving a list of television programs from the digital video recorder; an integrated display screen for displaying the list to a user", see col. 4 lines 5-7, 15-18, the abstract lines 5-12, see also Figs.1, 3, 5;

"a plurality of user controls for controlling the digital video recorder, a least one user control for receiving a selection of a listed television program", see col. 3 lines 1-2, Figs. 3, 5, col. 3 lines 26-37, col. 4 lines 43-65;

"and wireless transmitter for transmitting the selection to the digital video recorder to initiate recording or playback of the selected television program", see col. 4 lines 5-7, 15-18, col. 2 line 65 to col. 3 line 2, see also Figs.1, 3, 5;

the difference between the claimed invention and Shintani's disclosure is that a digital video recorder is not explicitly shown in Shintani's disclosure as claimed.

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However Shintani teaches that the communication between the remote control and the television can be used to assist in integrating new components into the television entertainment system (see col. 5 lines 32-33), and the Elliott reference shows a digital video recorder integrated into a television entertainment system (see Fig. 2, 3 item 200); an artisan would be motivated to combine the references to arrive at the claimed invention; this combination would result in a system that has a remote control device with an integrated display screen for controlling, inter alia, a digital video recorder. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claim 2 is disclosed, see Shintani at col. 4 lines 54-58, Elliott at col. 4 lines 52-54.

Claim 3 is disclosed, see Shintani at Fig. 3, Elliott at col. 4 lines 52-54.

Claims 4/2, 4/1 are disclosed, see Shintani's abstract lines 5-12, Fig. 3, col. 4 lines 54-58, Elliott at col. 4 lines 52-60.

Claims 5-7 are disclosed, see Shintani at Figs. 3, 5, Elliott at Figs. 2, 3 items 144, 200, col. 4 lines 52-60.

Claims 8, 9 are disclosed, see Shintani at Figs. 3, 5.

Claims 10, 11 are disclosed in view of the above combination because the remote control can control the digital video recorder, see Elliott at Figs. 2, 3 items 144, 200, and Shintani at Figs. 3, 5.

Claim 12 is disclosed, see Shintani at Fig. 5 item Rec (record).

Claim 13 is disclosed, see Shintani at col. 4 lines 2-3.

Claim 14:

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Shintani discloses:

“a wireless transmitter for transmitting a list of television programs to a remote control device”, see the abstract lines 5-12, col. 4 lines 9-18;

“a wireless receiver for receiving a selection of a listed television program from the remote control device; and a recording and playback subsystem for selectively recording or playing back the selected television program”, see col. 4 lines 5-18, col. 2 line 65 to col. 3 line 2, see also Figs. 1, 3, 5;

“a wireless receiver for receiving the list of television programs from the digital video recorder; an integrated display screen for displaying the list to a user”, see col. 4 lines 5-7, 15-18, the abstract lines 5-12, see also Figs. 1, 3, 5;

“a plurality of user controls for controlling the digital video recorder, a least one user control for receiving a selection of a listed television program from the user”, see col. 3 lines 1-2, Figs. 3, 5, col. 3 lines 26-37, col. 4 lines 43-65;

“and wireless transmitter for transmitting the selection to the digital video recorder to initiate recording or playback of the selected television program”, see col. 4 lines 5-7, 15-18, col. 2 line 65 to col. 3 line 2, see also Figs. 1, 3, 5;

the difference between the claimed invention and Shintani's disclosure is that a digital video recorder is not explicitly shown in Shintani's disclosure as claimed.

However Shintani teaches that the communication between the remote control and the television can be used to assist in integrating new components into the television entertainment system (see col. 5 lines 32-33), and the Elliott reference shows a digital video recorder integrated into a television entertainment system (see Fig. 2, 3 item 200);

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an artisan would be motivated to combine the references to arrive at the claimed invention; this combination would result in a system that has a remote control device with an integrated display screen for controlling, inter alia, a digital video recorder. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claim 15:

“an encoder for digitally encoding a television program in a compressed format”, see Elliott at Fig. 3 item 216;

“a mass storage device for storing the encoded television program”, see Elliott at Fig. 3 item ROTATING STORAGE DRIVE;

“a decoder for decoding a television program retrieved from the mass storage device”, see Elliott at Fig. 3 item 122;

“and a display controller displaying the decoded television program on an external device”, see Elliott at Fig. 3 items 120, 300.

Claim 16 is disclosed, see Elliott at col. 3 lines 35-36.

Claims 17-20 are disclosed, see Elliott at col. 4 lines 5-15, 52-65.

Claims 21-32 are rejected for the same reasons as claims 2-13.

Claim 33 is rejected for the same reasons as claim 1.

Claims 34-39 are rejected for the same reasons as claims 2-3, 5, 7, 9-10.

Claim 40 is rejected for the same reasons as claim 14.

Claims 41, 43 are rejected for the same reasons as claim 15.

Claim 42 is rejected for same the reasons as claim 16.

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Claims 44-51 are rejected for the same reasons as claims 17-22, 24, 26.

Claim 52 is rejected for the same reasons as claim 1.

Claim 53 is rejected for the same reasons as claim 14.

Claim objection

3. Claim 4 on page 28 and claim 4 on page 29 are objected to because they are numbered by the same number which is 4. Appropriate correction is required.


Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean W. Désir whose telephone number is (703) 308 9571. The examiner can normally be reached on 5/4/9 - First Friday Off.

5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (703) 305 4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 9306.

6. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306 0377.

JWD
Jan. 16, 04


MICHAEL H. LEE
PRIMARY EXAMINER